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Serial no. 10/062,976
Filed 1/30/2002
Attorney docket no. 10016646-1

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REMARKS

Claim rejections under 35 USC 102

All of the pending claims 1-36 have been rejected under 35 USC 102(b) as being anticipated by Krist (5,615,015). Applicant respectfully traverses the rejection as to the claims as have been amended.

Claimed invention (as amended)

For purposes of this office action, Applicant discusses independent claim 1, as amended, as representative of claimed invention. The distinctions that Applicant proffers in relation to claim 1 vis-à-vis Krist are applicable to all the pending claims, as have been variously amended.

Claim 1 is directed to a device having a first mechanism and a second mechanism. The first mechanism is for converting a received file according to a printer-independent page description language (PDL) into a first interim format. The second mechanism is for converting the received file as converted to a second interim format into a printer-specific printer language. (The first interim format may be the same as the second interim format, as in claim 2, or may be different than the second interim format, as in claim 3.)

Applicant has amended claim 1 as follows. The received file as converted into the printer-specific printer language is "printed by a printing device other than the device comprising the first and the second mechanisms." The idea here is to limit the claimed invention so that the claimed device that performs the two conversions noted in the claim language is a *different* device than the printing device that ultimately prints the received file.

Support for this amendment, and further explanation of the claimed invention, is found throughout the patent application as filed. For example, in FIG. 1, the dongle/appliance 104 converts the document 114 into a first interim format, and from a second interim format into the document 116 in the printer-specific language. The document 116 in the printer-specific language

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is then printed by the printer 118. Thus, the dongle/appliance 104 is not the printer 118 that prints the document 116 in the printer-specific language.

Therefore, Applicant has amended the claim language to better clarify the subject invention that is being presented for patenting. In particular, the claimed invention is a device that converts a received file in a PDL into a first interim format. Furthermore, the claimed invention is a device that converts the received file as has been converted to a second interim format into a printer-specific printer language – and, as amended, this converting device is not the device that prints this file in the printer-specific language.

Interpretation of Krist

The Examiner substantially relies upon column 3, line 56, through column 4, line 9, of Krist as teaching or disclosing the claimed invention as recited above. Therefore, Applicant focuses attention here on this same excerpt of Krist, which reads in relevant part as follows.

[T]here is provided a method including . . . using an emitter to convert the first electronic document, with the electronic job ticket, into a second electronic document written in a page description language, the second electronic document including respective page description language representations of the selected instruction and the selected electronic page; . . . interpreting the second electronic document at the printing machine to create an output-ready document, said interpreting including performing the image processing operation, on the page description language representation of the said electronic page, with the page description language representation of the selected instruction of the second electronic document; and outputting a representation of the interpreted second electronic document at the printing machine.

The Examiner did not specifically point out which aspects of this excerpt of Krist correspond to which aspects of the claimed invention. Therefore, for purposes of discussion, Applicant submits that a proper interpretation of Krist in relevant part vis-à-vis the claimed invention is as follows. Krist interprets a second electronic document to create an output-ready document, and Applicant believes that this interpretation of the second electronic document to create an output-ready document is that which most logically can be construed as corresponding

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to the claimed invention's converting the second interim format of the received file into a printer-specific printer language. (I.e., the second electronic document of Krist corresponds to the second interim format of the received file of the claimed invention, and the output-ready document of Krist corresponds to the printer-specific printer language conversion of the received file of the claimed invention.)

If the Examiner disagrees with Applicant's interpretation of Krist in this regard, he is respectfully requested to divulge how he is interpreting Kris vis-à-vis the claim language; however, Applicant submits that the provided interpretation of Krist is the broadest and most reasonable interpretation thereof vis-à-vis the claim language.

Patentable distinction between the claimed invention and Krist

Applicant submits that there is at least one patentable distinction between the claimed invention as amended and Krist – that the conversion of the received file from a second interim format into a printer-specific printer language is performed in Krist at the same printing device that prints the received file, which is in contradistinction to the claimed invention. That is, the recited functionality of the claimed invention is performed in a particular device that is different (i.e., other) than the printing device that ultimately prints the received file. By comparison, Krist does not have the recited functionality of the claimed invention being performed at such a particular device that is different (i.e., other) than the printing device that ultimately prints the received file.

Applicant submits that this distinction is clear from the excerpt of Krist that the Examiner has relied upon, as discussed above. In particular, Krist teaches “interpreting the second electronic document *at the printing machine* to create an output ready document” and “outputting a representation of the interpreted second electronic document *at the printing machine*.” (Col. 4, ll. 2-10) As has been discussed above, the interpretation of the second electronic document to create an output ready document corresponds to the conversion of the

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received file from a second interim format into a printer-specific printer language. However, whereas in the claimed invention the received file as converted into the printer-specific language is “printed by a printing device other than the device” that performs this conversion, in Krist the received file as converted into the printer-specific language is printed at the same printing machine that performs this conversion. That is, the received file is printed at the same printing machine at which the second electronic document is interpreted to create an output ready document, where this interpretation/creation in Krist corresponds to the conversion of the received file into the printer-specific printer language of the claimed invention.

Applicant notes that “anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” (W.L. Gore Assocs. v. Garlock, 721 F.2d 1540, 220 USPQ 303,313 (Fed. Cir. 1983)) The prior art reference must disclose each element of the claimed invention “*arranged as in the claim.*” (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)) As to the present patent application, Krist does not particularly teach each element of the claimed invention as arranged in the claim. That is, whereas in the claimed invention as has been amended the conversion of the received document from a second interim format into a printer-specific printer language is performed at a device other than a printing device that prints the received file, in Krist this conversion is performed at the printing device that prints the received file. The arrangement of the recited functionality of the claim language differs from that disclosed in Krist, and this is why Krist does not anticipate the claimed invention.


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Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicant's representative, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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